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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,943

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Masanori Asada

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

08/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,943

Applicant(s)

ASADA ET AL.

Examiner

Taofiq A. Solola

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

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Claims 1-6 are pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinto et al., WO 01/49674 A2, alone or in view of Kajimoto et al., J. Jpn. Soc. Nutr. Food Sci. (2000), Vol. 53, pp. 199-205.

Applicant claims compound and composition in claim 1 for inhibition of α -glucosidase. In preferred embodiment, the compound or composition is mixed with food, and the source (Salacia reticulata) is claimed.

Determination of the scope and content of the prior art (MPEP §2141.01)

Pinto et al., teach Salacia reticulata extract as kotalanol compound and composition thereof for inhibition of α -glucosidase. See page 2. Pinto et al., also teach the racemates and isomers of kotalanol compound, wherein R6 is optionally substituted alkyl or alkenyl. See the abstract, formula I, page 5, and compounds A-C, page 9.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant invention and that of Pinto et al., is the length of the carbon chain of the compounds. Also, Pinto et al., did not teach mixing the compound with food.

Finding of prima facie obviousness--rational and motivation (MPEP §2142.2413)

However, Kajimoto et al., teach mixing of Salacia reticulata extract with food. When the difference between compounds is the length of a carbon chain such are adjacent homologs.

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However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950).

Therefore, the instant invention is prima facie obvious from the teachings of Pinto et al., and Kajimoto et al. One of ordinary skill in the art would have known to claim the instant compound and add it to diabetic diet at the time the invention was made. The motivation is from knowing that adjacent homologs would have similar biochemical properties, and because Pinto et al., teach the compound as having α -glucosidase inhibitory property.

Objection

Claims 2-3 are substantial duplicates of claim 1, and claim 6 is a duplicate of 5. Under the US patent practice the source of a product or how it is made is not a limitation. Also, once either the compound or its composition is mixed with food, the resulting diet is the same. Under the US patent practice substantial duplicate claims cannot be in the same application, and applicant must delete the duplicate claims.

Priority Document

This application claims priority of a foreign document. However, English translation of the foreign document is not yet received.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

August 2, 2007